

### **REMARKS**

In response to the Office Action dated June 15, 2005, Applicants respectfully request reconsideration and withdrawal of the rejections and objections to the claims.

At the outset, Applicants note that the Office Action was accompanied by a copy of Form 1449 listing the two references cited in the Information Disclosure Statement filed April 25, 2002. The Examiner's initials appear adjacent to the listing of the two references, which implies that the Examiner considered the references. However, the citations of the references were also stricken through, which suggests that they are not being made of record. The Examiner is respectfully requested to clarify whether the references cited in the Information Disclosure Statement have been considered, and if so whether they will be made of record. If the references were not considered, the Examiner is respectfully requested to explain the reasons therefor, since it is believed that the Information Disclosure Statement complies with the requirements of 37 C.F.R. §1.97, and therefore Applicants are entitled to have the references considered.

In response to the Examiner's request, the title has been amended to further specify the subject matter embraced by the claims.

Claims 7, 8 and 9 were rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. In response thereto, these claims have been amended to more explicitly recite that the claimed computer program is embodied in a computer-readable medium. As such, it is respectfully submitted that the claims fall within one of the classes of statutory subject matter set forth in 35 U.S.C. §101.

In response to the objections to claims 1-9 as containing minor informalities, claims 1, 4 and 7 have been amended as suggested by the Examiner, to confirm his interpretation thereof.

Claims 1, 2, 4, 5, 7 and 8 were rejected under 35 U.S.C. §102, on the grounds that they were considered to be anticipated by the Hansen patent (US 6,509,974). Claims 3, 6 and 9 were rejected under 35 U.S.C. §103 as being unpatentable over the Hansen patent in view of two additional references. It is respectfully submitted that the Hansen patent does not anticipate, nor otherwise suggest, the claimed subject matter, whether considered by itself or in combination with the other references.

Claim 1 recites a printing system that comprises an on-line client, print server and printer, as well as an off-line finishing device. The claim recites that the print server includes, among other elements, a sorting means for separating finishing specifics included in a job ticket into those to be performed by the printer and those to be performed by the finishing device. The print server further includes a setting means for setting parameters for finishing specifics in the printer as separated by the sorting means and assigned to the printer. The print server also includes a creating means for creating a finishing device job ticket that includes the finishing specifics separated by the sorting means and assigned to the finishing device. Thus, in accordance with the claimed subject matter, when the print server receives a job ticket that includes finishing specifics, it sorts those finishing specifics into those that are performed by the on-line printer, and those that are performed by the off-line finishing device. It then sets up the printer with those finishing specific parameters

that it has determined are to be performed by the printer, and creates a job ticket that identifies the finishing specifics that are to be performed by the finishing device.

It is respectfully submitted that the Hansen patent does not disclose these claimed elements. If anything, it teaches away from the claimed subject matter.

With reference to column 7, lines 30-42, the Office Action notes that the Hansen patent discloses that the print server 120 functions to direct print jobs to specific ones of the production output devices 122. The patent does not disclose, however, that in performing this function the print server separates finishing specifics between those that are to be performed by an on-line device, such as a printer, and those that are performed by an off-line device, such as a finisher. Referring to column 11, lines 53-63, the patent states that when a production output device 122 receives a file for printing, it interprets the instructions to implement the desired feature. Since the output device is receiving a file, it can be assumed that this portion of the disclosure is referring to an on-line device. The patent goes on to state:

For page features which the current device 122 cannot handle the device 122 can signal the operator that manual intervention is required and direct the operator through the appropriate steps to implement the page feature and complete the job. This may include instructing the operator to remove partially finished documents and transfer them to a binding machine for finishing...

From the foregoing, it can be appreciated that the print server does not function to *separate* finishing specifics that are appropriate for the on-line device from those that are to be performed by the off-line device. Rather, *all* of the finishing specifics are sent to the on-line device, i.e. the current device 122 as set forth in the foregoing quote. It is then up to *that* device to determine which features it is capable

of performing, and to signal the operator when it cannot perform a process that must be transferred to an off-line machine.

Accordingly, it is respectfully submitted that the Hansen patent does not disclose a sorting means of the type recited in claim 1. Since it does not disclose the sorting means, it also cannot be interpreted to disclose a setting means which sets finishing specific parameters in the printer "as separated by the sorting means and assigned to the printer," or a creating means that creates a job ticket including finishing specifics "separated by the sorting means and assigned to the finishing device."

In summary, therefore, the Hansen patent does not disclose a print server that functions to separate finishing specifics into those that are to be performed by the printer and those to be performed by an off-line finishing device, and then to set the printer accordingly, and create a job ticket for the finishing device, in accordance with those separated operations. Rather, the Hansen patent discloses that *both* the operations that are appropriate for the on-line device and those that are to be performed by the off-line finisher are sent to the on-line device. The system of the Hansen patent relies upon the on-line device to recognize which operations it is incapable of performing, and to signal the operator accordingly.

For at least these reasons, therefore, it is respectfully submitted that the Hansen patent does not anticipate the subject matter of claim 1. For the same reasons, the subject matter of independent claims 4 and 7 is not anticipated, as well as their respective dependent claims 2, 5 and 8, and new claims 10, 11, 13 and 14.

In the rejection of claims 3, 6, and 9 under 35 U.S.C. §103, the Office Action relies upon the Rourke patent as disclosing a reading means for reading job

information from data obtained via a scanner. The Jeyachandran patent was relied upon as teaching a notifying means for notifying the client of a job completion based upon user information. However, these teachings do not overcome the fundamental distinctions between the claimed subject matter and the Hansen patent discussed above. Accordingly, it is respectfully submitted that any possible combination of the Rourke and/or Jeyachandran patents with the Hansen patent does not lead a person of ordinary skill in the art to the claimed subject matter.

It is respectfully submitted that all pending claims are patentably distinct from the prior art of record. Reconsideration and withdrawal of the rejections are therefore respectfully requested.

Respectfully submitted,

BUCHANAN INGERSOLL PC

Date: September 15, 2005

By: \_\_\_\_\_



James A. LaBarre

Registration No. 28,632

P.O. Box 1404  
Alexandria, Virginia 22313-1404  
(703) 836-6620